

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/551,278	Applicant(s) ROELOFFS, BOB
Examiner RYAN A. VARNUM	Art Unit 3751

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 April 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3,8,11,16,33-35,37 and 38.
Claim(s) withdrawn from consideration: 9,13,15,20,21 and 23.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) _____.
13. ☐ Other: _____.

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive.

FINALITY OF THE ACTION ISSUED 12/16/2009 --- Applicant has argued that the finality of the action issued on 12/16/2009 was improper, as having relied on newly introduced art not previously presented, thereby failing to provide Applicant with an opportunity to address the application of the new art to the claimed subject matter. The Examiner respectfully disagrees.

The MPEP provides that any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In this instance, Applicant had submitted claim amendments on 3/23/2009. Those claim amendments necessitated the application of the newly cited art in the action of 12/16/2009, and as such, the action was made final. Accordingly, it is the Examiner's position that the finality of the action was proper, and is therefore maintained.

FINALITY OF THE FINDING OF A LACK OF UNITY --- Applicant has asserted that the finality of unity requirement was premature as the prior art of Brosius was first cited in the action issued 12/16/2009. The Examiner respectfully disagrees.

The unity requirement issued on 7/20/2009 indicated that the numerous species lacked unity as they failed to satisfy the first requirement of the special technical feature determination; specifically, the numerous species lacked the same or corresponding special technical features. Accordingly, it was not necessary for the Examiner to cite prior art in support of the second requirement of the special technical feature test showing that a same or common special technical feature did or did not read over the art.

Upon responding to the unity requirement, Applicant amended the claims and further asserted that the numerous species shared the common special technical features which encompassed the entirety of Claim 1 (See Applicant's Response to Election/Restriction filed 8/18/2009, reciting the entirety of the limitations of Claim 1 as the special technical feature). The Examiner addressed Applicant's arguments by citing prior art (Brosius) which indicated that the asserted special technical feature failed to read over the prior art. That cited prior art was also then incorporated into the rejection which was necessitated by the amendment, thereby requiring that it be made final.

Accordingly, it is the Examiner's position that the finality of the unity requirement was proper, and is therefore maintained.

INSUFFICIENCY OF THE PURPORTED SPECIAL TECHNICAL FEATURES --- Applicant has asserted that the special technical features which are common across the species in the current application are those features which are recited in independent Claim 1.

Contrary to Applicant's arguments, it is the Examiner's position that the purported common technical features fail to satisfy at least the second requirement of the special technical feature test as they fail to read over the prior art in view of Brosius, as presented in the action issued 12/16/2009.

Furthermore, even were Brosius found insufficient to meet the limitations of the purported common technical features, which it is not, these purported special technical features would still fail to satisfy the first requirement of the test. The limitations of Claim 1 recite in part "...a first elongated leg and a second elongated leg WHICH EXTEND SUBSTANTIALLY PARALLEL TO AN EDGE OF THE WRITING MEMBER FACING THERETO, each of the first and second legs having respective first and second ends, wherein THE FIRST LEG FIRST END AND THE SECOND LEG FIRST END of the clamping device ARE BENDABLY CONNECTED TO THE WRITING MEMBER NEAR THE WRITING TIP...". However, Applicant's attention is directed to Species III (Fig. 6) and Species XII (Fig. 14). In Species III (Fig. 6) it can be seen that of the two legs 607, only one of the legs is actually connected by a first end to the writing member near the writing tip. Furthermore, in Species XII (Fig. 14) it can be seen that of the two legs 1407/1406 (recalling that the legs must run "parallel to an edge of the writing member facing thereto") that neither of these legs has a first end which is connected to the writing member near the writing tip.

Accordingly, the Examiner's previous position that there is no same or corresponding special technical feature common to the numerous species is hereby maintained; thereby further supporting the finality of the unity requirement.

REJECTION OF CLAIM 1 OVER BROSIUS --- Applicant has argued that the prior art of Brosius (US 1,840,563) does not properly read on the limitations of Claim 1. However, these arguments are based on new matter which lacks support in the specification, and which also does not read on the elected Species IV (Fig. 9A).

Applicant's specification does not disclose, nor does it require, the application of the special definition asserted by Applicant for the term of a "leg". As such, the Examiner has applied the broadest reasonable interpretation of "a branch or part of an object or system" (See Merriam-Webster Dictionary) as required by the MPEP. Furthermore, the elected Species IV (Fig. 9A) does not disclose "legs" that have ends defined at an extremity of a continuous body.

Regarding Applicant's argument attempting to distinguish the claimed subject matter from Brosius by arguing that Brosius fails to disclose the first ends of the legs being "connected to AND CONTACTING the writing implement"; such arguments will not be considered at this time where the claim limitations currently under consideration do not require the legs to contact the writing implement.

Accordingly, the 102(b) rejection of Claim 1 over Brosius is maintained.

MALE-FEMALE CONNECTION --- Applicant has asserted that the Examiner's rejection of Claim 34 which requires a male-female connection is inappropriate in so far as "two flat surfaces which may touch do not constitute a male-female connection, and that the shaft of a pencil cannot be considered a male connector". The Examiner respectfully disagrees.

It is the Examiner's opinion that it is well known in the art that a shaft (i.e. - the shaft of the pencil) being inserted into a cavity (i.e. - the cavity of the tubular body) is the most fundamental of male-female connections.

Accordingly the 102(b) rejection of Claim 34 over Brosius is maintained.